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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,949	01/17/2006	Diego Anza Hormigo	P1942US	4094
8968 7590 06/11/2009 DRINKER BIDDLE & REATH LLP ATTN: PATENT DOCKET DEPT. 191 N. WACKER DRIVE, SUITE 3700 CHICAGO, IL 60606				
EXAMINER				
HUYNH, NAM TRUNG				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/564,949

**Applicant(s)**

ANZA HORMIGO ET AL.

**Examiner**

NAM HUYNH

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed on 2/17/2009. Of the previously presented claims 1-13; claims 1, 3, 4, and 10 have been amended and claims 2 and 13 have been cancelled.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1 and 2-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Independent claims 1 and 10 recite the limitation "indicating that the message is delivered" in the fourth to last line of the claim. This limitation lacks antecedent basis since there is no previous mention of a "message" in the claim.
4. Claims 3-9 are rejected based on dependence of claim 1 and claims 11 and 12 are rejected based on their dependence of claim 10.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 4, and 6-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Ouzounidis et al. (US 7,130,918) (hereinafter Ouzounidis).

Regarding claim 1, Ouzounidis teaches a method for informing an application server (presence server) whether or not a mobile subscriber is present on a mobile telecommunication network, the method comprising:

a first step for sending a first signal distinctive of the mobile subscriber to the mobile telecommunication network (SMS-C), intended for the mobile subscriber (an SMS message is sent from the presence to the SMS-C);

a second step for determining a present or not present binary state according to a reaction of the mobile telecommunication network to said first signal (SMS-C determines if message is delivered to the mobile telephone); and

a third step for communicating to the application server the state determined in the second step (SMS-C sends an acknowledgement back to the presence server of where the mobile telephone is available);

wherein:

a first transition enabled by a reaction of the mobile telecommunication network indicating that the message is delivered (SMS-C acknowledges to the presence server that the mobile telephone is available), respectively a second transition enabled by an

expiry of a time delay (specified time limit) without reaction from the mobile telecommunication network, activates the second step that determines the present, respectively not present state of the mobile subscriber (the SMS-C determines that the mobile telephone is unavailable if the message is not delivered within the specified time limit) (column 7, lines 5-30).

Regarding claim 4, Ouzounidis teaches the first step is activated during an activation of the second step by positioning a time delay that is a function of the present or not present state determined in the second step (column 7, lines 5-30).

Regarding claim 5, Ouzounidis teaches a step of a wait time activated when the second step determines the present state so as to activate the first step after expiry of the wait time (paragraph 134).

Regarding claim 6, Ouzounidis teaches said first signal consists of a telecommunication network node interrogation of the present or not present state of the mobile subscriber (SMS-C interrogates availability with SMS); and

the reaction of the mobile telecommunication network includes a response of the telecommunication network node on the present or not present state of the mobile subscriber (SMS-C responds to request of presence server with acknowledgment) (column 7, lines 5-30);

Regarding claim 7, Ouzounidis teaches said first signal consists of a positioning of a detection point on a telecommunication network node relating to any modification of the present or not present state of the mobile subscriber (SMS is used to detect availability of the mobile telephone); and

the reaction of the mobile telecommunication network includes a notification of the telecommunication network node (SMS-C) relating to each modification of the present or not present state of the mobile subscriber (SMS-C acknowledges to presence server whether the mobile telephone is available or not) (column 7, lines 5-30).

Regarding claim 8, Ouzounidis teaches an activation of the third step communicating the present state to the application server is followed by an activation of the third step communicating the not present state to the application server when the state determined in the second step passes from present to not present (the SMS-C reports to the presence server that the mobile telephone is unavailable) (column 7, lines 5-30).

Regarding claim 9, Ouzounidis teaches an activation of the third step results from a transition enabled by a request originating from the server to request the state of the mobile subscriber (message is sent from presence server to the SMS-C to determine availability) (column 7, lines 5-30).

Regarding claim 10, the limitations are rejected as applied to claim 1.

Regarding claim 11, Ouzounidis teaches the first means is arranged to send the first signal in the form of a short message intended for the mobile subscriber (SMS-C sends SMS to mobile telephone); and

the second means is arranged to determine the present state when the short message is delivered and to determine the not present state when the short message is not delivered after expiry of a preset time delay (SMS-C determines that the mobile

telephone is unavailable when the message is not delivered in a specified time period) (column 7, lines 5-30).

Regarding claim 12, Ouzounidis teaches the first means is arranged to send said first signal at regular time intervals that depend on the present or not present state of the mobile subscriber (SMS is used to determine if the availability of the mobile telephone) (column 7, lines 5-30).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ouzounidis et al. (US 7,130,918) (hereinafter Ouzounidis) in view of Ganor (US 2004/0219908).

Ouzounidis teaches said first signal is a short message sent to the mobile telecommunication network intended for the mobile subscriber (column 7, lines 5-30), but does not explicitly teach positioning a data coding scheme parameter in a header of the short message at a value that has the effect of commanding the mobile receiving the message to discard the content of the message and to deactivate a message received indication on the mobile. Ganor discloses a method and system for detecting availability of a wireless device (title). Ganor teaches positioning a data coding scheme parameter in a header of the short message (SMS0) at a value that has the effect of commanding the mobile receiving the message to discard the content of the message and to deactivate a message received indication on the mobile (paragraphs 10-12). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Ouzounidis to send a SMS with a header which is not indicated to the user of the handset, as taught by Ganor, in order to prevent the determination of availability to interfere with the user and so that the message can be automatically discarded.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ouzounidis et al. (US 7,130,918) (hereinafter Ouzounidis) in view of O'Neil et al. (US 7,127,232) (hereinafter O'Neil).

Ouzounidis teaches the limitations of claim 4 and a step of a wait time activated when the second step determines the present state (column 7, lines 5-30), but does not explicitly teach activating the first step after expiry of the wait time. O'Neil discloses



multiple access internet portal revenue sharing. O'Neil teaches that if a phone can not be reached by a SMSC the message will be retry transmission (column 12, lines 20-28). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Ouzounidis to retry transmission of the SMS message after the specified time period, as taught by O'Neil, in order to continue monitoring to determine when the mobile telephone becomes available.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1 and 3-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAM HUYNH whose telephone number is (571)272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/  
Supervisory Patent Examiner, Art Unit 2617

/Nam Huynh/  
Examiner, Art Unit 2617